

### ***INTERVIEW SUMMARY***

Applicants representative, Sheldon L. Wolfe (43,996), conducted a telephonic interview with Examiner Ponomarenko. First, Examiner Ponomarenko reiterated his position with respect to claim 1. The Examiner then stated a claim incorporating the limitations of claims 1, 10, 13, 14, 15, and 16 would probably be allowable. Attorney Wolfe responded by noting that claim 1 is not anticipated by the prior art, and Applicants plan to argue that claim 1 is not obvious in view of the prior art. Attorney Wolfe also noted that the prior art does not teach or suggest a connector having a first positive terminal, a second positive terminal, and a ground terminal, particularly the terminals having multiple power states. The parties also discussed the objections to the claims. No agreement was reached.

## **REMARKS**

Reconsideration and allowance of the application are respectfully requested. By this Amendment, claims 8, 9, and 18-38 have been cancelled, claims 1, 10, 11, and 17 have been amended, and claims 39-46 have been added. Claims 1-7, 10-17, and 39-46 are pending in the application.

### **A. Election/Restrictions**

The Office indicated that the application contains the following three groups of claims directed to patentably distinct inventions:

- I. Claims 1-17, drawn to a portable power source.
- II. Claims 18-33, drawn to a system for starting engine-driven equipment.
- III. Claims 34-38, drawn to a method of operating an engine starter.

Applicants elect Group I and have cancelled claims 18-38 without prejudice.

### **B. Drawings**

The Office objected to the drawings stating that the drawings do not show the fuel cell of claim 17. The fuel cell has been removed from claim 17, thereby rendering the objection moot. However, Applicants assert that the electrochemical power supply can include a fuel cell.

### **C. Claim Objections**

The Examiner objected to claim 6, stating the words "one or more keyed terminals" are indefinite. Applicants amended claim 6 to recite "at least one keyed terminal." Applicants request withdrawal of the objection to claim 6.

The Examiner objected to claim 8, stating the words "terminal(s) are coupled... when the switch is in the ON position" are confusing. Applicants cancelled claim 8, thereby rendering the objection moot.

The Examiner objected to claim 9, stating the words "terminal(s) are coupled... when the switch is in the START position" are confusing. Applicants cancelled claim 8, thereby rendering the objection moot.

The Examiner objected to claim 10, stating the words "connector operable to receive at least one of alternating current and direct current" are confusing. Applicants amended claim 10 to recite "a current." Applicants request withdrawal of the objection to claim 10.

The Examiner objected to claim 11, stating the words "cable . . . adapted to be connected to the connector" are confusing. Applicants amended claim 11 to recite a cable having second and third connectors. Applicants request withdrawal of the objection to claim 11.

**D. Claim Rejections – 35 USC § 103(a)**

*I. Claim 1*

Claim 1 stands rejected as being unpatentable over USPN 6636015 (Levine) or USPN 6400121 (Tracey) in view of USPN 5967304 (MacKay) and USPN 4389166 (Harvey). To establish a *prima facie* case of obviousness, three basic criteria must be met. *M.P.E.P.* § 706.02(j) and 2143.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, not in applicants' disclosure.

Applicants contend that the Office's proposed combination does not meet the *prima facie* case of obviousness for claim 1.

As the Office acknowledges, neither the Levine nor the Tracey references teaches or suggests a switch electrically connected to the electrochemical power supply, the switch having an ON position with a fixed contact and a START position with a momentary contact. See page 5 of the pending Office action. It should also be noted that the Harvey reference does not teach or suggest a switch electrically connected to the electrochemical power supply, the switch having an ON position with a fixed contact and a START position with a momentary contact. See page 5 of the pending Office action.

Rather, the Office states, "Official notice is taken of the fact that the claimed switch type is well known in the art and is [a] common item for the designer of power control equipment. . . .

MacKay et al. teaches a rotary switch with a plurality of different settings, such as a [momentary setting], an off setting and low and high power stable settings (abstract)." Applicants do not dispute that the prior art disclose a switch having an OFF position, an ON position with a fixed contact, and a START position with a momentary contact. See, for example, the MacKay reference. However, the Office still needs to show that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. The Applicants assert the Office has not met this burden.

More specifically, the Office attempts to show motivation or suggestion by arguing that the claimed switch is a common item for the designer of power control equipment and

"[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to design a portable power source . . . to use a three position switch with [momentary] and fixed positions . . . in order to have a convenient operation of the start switch . . . , especially since. . . it appears that the claimed combination of a well known [feature] is within capabilities of an ordinary designer in the art."

Basically, the Office asserts the claim is unpatentable because portable power sources are known, three position switches are known, and it would be "within the capabilities of an ordinary designer in the art" to combine the two. However, "the level of skill in the art cannot be relied upon to provide the suggestion to combine references," which the Office appears to be doing by stating the claimed combination is "within capabilities of an ordinary designer in the art". See MPEP 2143.01 I, citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Furthermore, "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." (Emphasis added.) MPEP 2143.01 IV citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). The Office does suggest the combination provides "a convenient operation." However, convenience is a subject determination, and is not an objective reason. Moreover, Applicants assert that this reason is based on the hindsight of Applicants' disclosure, and not on

the reference teachings. Therefore, the Office has not established a prima facie case of obviousness since the Office did not show a proper suggestion or motivation to modify the references or to combine the reference teachings

Regardless, Applicants amended claim 1 to further distinguish claim 1 from the cited references. Claim 1 now recites that the switch "allows a momentary current from the electrochemical power supply to the connector only for the duration the switch is manually held in the START position," and that "is configured to allow a fixed current from the electrochemical power supply to the connector when the switch is manually switched to the ON position."<sup>1</sup> The portable power sources cited by the Office only provides a continuous power (or current), and therefore does not teach or suggest allowing a fixed current and a momentary current. The MacKay reference generally discloses a rotary electric switch "which provides stable state positions and at least one momentary switch position." Col. 3, lines 31-35. However, there is no teaching or suggestion to allow a current (either a momentary current or a fixed current) from an electrochemical power supply to a connector of a portable power source. The Harvey reference simply discloses a self-contained portable air compressor. Therefore, the cited references do not meet the third prong of the prima facie case of obviousness for amended claim 1.

Accordingly, claim 1 is allowable.

Dependent claims 2-7, 10-17, and 39-46 depend from claim 1, and are thus allowable for the same reasons as discussed with respect to claim 1, as well as for other reasons that may or may not be discussed herein.

In the telephonic interview between the Examiner and Applicants' representative, the Examiner indicated that a claim having the limitations of claims 1, 10, 13, 14, 15, and 16 may be allowable. Applicants assert claim 46 corresponds to the Examiner's suggested claim.

Applicant's assert that none of the cited references, either alone or combined, teach or suggest the following limitations. If the Examiner disagrees, then the Applicants request the Examiner to cite where the references teach the following limitations.

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<sup>1</sup> Claim 1 recites that the switch is configured to "allow" a current. This wording does not imply that a current is in fact present. Rather, a current may be present or the switch permits a current.

- A portable power source having a switch that is electrically connected to an electrochemical power supply and to a connector, configured to allow a fixed current through a first positive terminal and a ground terminal of the connector, but not a second positive terminal of the connector, when the switch is in the ON position. (See claims 39, 41, 43, and 45.)
- A portable power source having a switch that is electrically connected to an electrochemical power supply and to a connector, and configured to allow a momentary current through a second positive terminal and a ground terminal of the connector, but not a second positive terminal of the connector, when the switch is in the ON position. (See claims 40, 41, 44 and 45)
- A portable power source including, among other things, a single connector having a first positive terminal, a second positive terminal, and a ground terminal. (See claim 42)

### **CONCLUSION**

Entry of the Amendment and allowance of claims 1-7, 10-17, and 39-46 are respectfully requested. The undersigned is available for telephone consultation at any time during normal business hours.

Respectfully submitted,



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